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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/965,806	10/01/2001	Darrell T. McKenzie	DANA-138	3402
23599	7590	01/21/2004	EXAMINER	
MILLEN, WHITE, ZELANO & BRANIGAN, P.C. 2200 CLARENDON BLVD. SUITE 1400 ARLINGTON, VA 22201			CECIL, TERRY K	
		ART UNIT	PAPER NUMBER	
			1723	

DATE MAILED: 01/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)
	09/965,806	MCKENZIE, DARRELL T.
	Examiner Mr. Terry K. Cecil	Art Unit 1723

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1) Responsive to communication(s) filed on 28 December 2003.

2a) This action is **FINAL**. 2b) This action is non-final.

3) Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4) Claim(s) 1-11 is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5) Claim(s) _____ is/are allowed.

6) Claim(s) 1-11 is/are rejected.

7) Claim(s) _____ is/are objected to.

8) Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9) The specification is objected to by the Examiner.

10) The drawing(s) filed on _____ is/are: a) accepted or b) objected to by the Examiner.
 Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11) The proposed drawing correction filed on 28 November 2003 is: a) approved b) disapproved by the Examiner
 If approved, corrected drawings are required in reply to this Office action.

12) The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13) Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
 a) All b) Some * c) None of:
 1. Certified copies of the priority documents have been received.
 2. Certified copies of the priority documents have been received in Application No. _____.
 3. Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
 * See the attached detailed Office action for a list of the certified copies not received.

14) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).
 a) The translation of the foreign language provisional application has been received.

15) Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) <input type="checkbox"/> Notice of References Cited (PTO-892)	4) <input type="checkbox"/> Interview Summary (PTO-413) Paper No(s). _____
2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)	5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152)
3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____	6) <input type="checkbox"/> Other: _____

DETAILED ACTION

Claim Rejections - 35 USC § 103

1. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

2. Claim 1-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Hultgren et al. (U.S. 3,369,666) in view of Buckman (U.S. 3,567,203) or in view of Turman (U.S. 3,802,564).

Hultgren discloses a combination filter element support and anti-prefill valve comprising the following:

- a unitary body (the entire invention as shown in figure 2) including
 - (i) an annular portion 48 that includes an annular shoulder (adjacent the leader of "54") extending radially to support the filter endcap 42,
 - (ii) a sealing section 50 including sealing ring 51 engaging the end plate 18 at an area coaxial and surrounding the central spin-on opening, and
 - (iii) a radially extending plate portion 62 having an axially positioned one-way valve 76 that opens in an axial direction toward the spin-on opening. Hultgren claims and describes his combination filter element support and anti-prefill valve as "unitary" (col. 6, lines 20-

23) and also as being “integral” or as a “single unit” (see col. 3, lines 45-46) [as in claim 1];

- a hollow core defined by tube 38 receiving the annular portion therein [as in claim 2];
- a filter cartridge 12 in combination with the unitary body and including an annular filtering element having an annular filtering media 16 for filtering engine oil [as in claims 7, 8 and 9];
- a one-way valve that is a purse valve 76 that includes a pair of lips 78 that project away from the hollow core; are joined by side wall web portions 82 (as shown in both figure 2 and figure 3); that biasingly intersect along a line 80; and that open in response to fluid pressure [as in claims 3 and 4];
- a plate portion 62 located at the end of the annular second 52, opposite the sealing section 50 and spaced from the annular shoulder to form a chamber for receiving the one-way valve [as in claims 5 and 10], *wherein the plate portion includes a web portion that is supported in spaced relation from the end plate only at a peripheral portion (the peripheral portion is integral with the substantially vertical portion intersecting the leader of reference no. “8”;*
and
- a unitary body that is made of rubber (col. 4, line 9) [as in claims 6 and 11].

As shown in figure 2, Hultgren teaches his unitary combination filter element support and anti-prefill valve to be made of a plurality of pieces: sleeve 52 is joined to elastomeric valve 76 with a snap fit (col. 4, line 73) and is joined to sleeve 50 with a clamp fit (col. 3, lines 64-65).

Hultgren does not teach a unitary body being of a single piece. However, Buckman teaches a unitary body that includes filter element support and valve portions and that is also of a single

piece (figure 7) [as in claim 1]. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the filter element support and valve of Hultgren to be of a single piece as in Buckman, since Buckman teaches the benefit of few parts “to reduce the costs of manufacture and assembly”. This would enhance the economy and “fool proof” operation desired by Hultgren (see col. 2, lines 52-56 of Hultgren).

In addition, Turman also teaches a unitary body 78 integrally molded rubber (col. 2, line 60) as a single piece [as in claim 1] including a purse valve portion, an annular portion 80, and a radially extending shoulder portion 82 positioned between the filter element and end plate. It is considered that it would have been obvious to one ordinarily skilled in the art at the time of the invention to have the filter element support and valve of Hultgren to be of a single piece as in Turman, since such would reduce the number of parts and save costs associated with assembly of his parts—as desired by Hultgren (see col. 2, lines 52-56 of Hultgren).

Response to Arguments

3. Applicant's arguments filed 11-28-03 have been fully considered but they are not persuasive because of the following reasons:

- Concerning applicant's argument about the secondary references, Buckman and Turman have been relied upon solely for their teachings of a valve for a single unitary piece. The examiner contends that reasons given about provide sufficient motivation for combining the references.

- In response to the applicant's new limitations concerning the plate portion, the examiner contends that upon modification of Hultgren with either Buckman or Turman, there is no structural differences between the modified Hultgren unitary valve and that of the claimed invention.
- Applicant has argued that Hultgren does not teach a one-way valve having the function of "closing to prevent oil or fuel from flowing through the central spin-on opening and into the hollow core of the filter element and opening when fluid is being circulated under pumping pressure." However, the examiner contends that the one-way valve of Hultgren can perform the aforementioned function as taught in the following passage of col. 4.

the central opening formed by the nipple 32. The duck bill configuration of the flexible anti-drain back valve 76 will permit the oil to flow only in one direction there-
60 through since the knife edge or lip edge 80 of the valve will prevent the oil from flowing in a reverse direction through the anti-drain back valve when the engine is shut down. At this time the lips will return to their free state original position, and form a tight seal and prevent
65 the return of oil flow through the valve. It will be noted

Conclusion

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a). A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the

advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Contact Information:

- Examiner Mr. Terry K. Cecil can be reached at (571) 272-1138 at the Carlisle campus in Alexandria, Virginia for any inquiries concerning this communication or earlier communications from the examiner. Note that the examiner is on the increased flextime schedule but can normally be found in the office during the hours of 8:30a to 4:30p, on at least four days during the week M-F.
- Wanda Walker, the examiner's supervisor, can be reached at (571) 272-1151 if attempts to reach the examiner are unsuccessful.
- The Fax number for this art unit for official faxes is 703-872-9306.



Mr. Terry K. Cecil
Primary Examiner
Art Unit 1723

TKC
January 12, 2004